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| 10/824,118 | 04/14/2004 | Haimanot Bekele | 9209M | 6444 |
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| EXAMINER MAHYERA, TRISTAN J | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/824,118

Applicant(s)

BEKELE ET AL.

Examiner

TRISTAN J. MAHYERA

Art Unit

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-16 and 18-24 is/are pending in the application.
- 4a) Of the above claim(s) 18-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-16 and 22-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____
- Paper No(s)/Mail Date ____

DETAILED ACTION

Receipt is acknowledged of the Applicant's remarks and amendments filed 3/27/2008.

Status of Claims

Claims 1-6, 8-16 and 18-24 are pending. Claims 18-21 have been withdrawn as being drawn to the non-elected invention. Claims 7 and 17 have been cancelled. Claims 1-6, 8-16 and 22-24 are examined on the merits.

Priority

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

Specification

The objection to the specification for the use of the trademarks WACKER 803/804, PERMETHYL 99A, CARBOWAX, ROSSWAX, GLOSSAMER L-6600, BENTONE GEL ISD and FLAMENCO SUPERPEARL has been **withdrawn in light of Applicant's amendments**.

Claim Rejections - 35 USC § 102

The statutes under this section can be found in a prior office action.

The rejection of Claims 1-16 under 35 U.S.C. 102(b) as being anticipated by DRECHSLER et al (US 6,139,823, see PTO-1449 dated 12/10/2004) is hereby **withdrawn in light of Applicant's amendments to claim 1.**

Claim Rejections - 35 USC § 103

The statutes and rules under this section can be found in a prior office action.

The rejection of Claims 17-24 under 35 U.S.C. 103(a) as being unpatentable over DRECHSLER in view of NICHOLS (US 6,010,709- see PTO-892) is hereby **withdrawn in light of Applicant's amendments.**

Claims 1-6, 8-16 and 22-24 are **newly** rejected under 35 U.S.C. 103(a) as being unpatentable over DRECHSLER (US 6,139,823, see PTO-1449 dated 12/10/2004) in view of NICHOLS (US 6,010,709- see PTO-892).

DRECHSLER teaches a cosmetic composition comprising an organosiloxane resin, a diorganosiloxane polymer and a volatile carrier. See e.g. col 1 lines 15-17; instant claim 1. Modified silicones, specifically aminosilicones, i.e. the amino alkyl side of silicone are used in the cosmetic composition. See e.g. claim 6 (amino alkyl side of silicone); instant claim 1. The use of organosiloxane resin is exemplified in claim 1 line 7; instant claim 1. Volatile carrier is taught in claim 1 line 12. Example 6 is anhydrous, as no water is used. See example 6, col 19; instant claim 1. Examples of thickeners used are propylene carbonate and bentonite clay. See e.g. example 29 col 34 line 66 to col 35 line 1; example 29 col 34 line 48; instant claims 2, 3 and 4. The organosiloxane

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resin comprises $R_3SiO_{1/2}$ "M" units, $R_2SiO_{1/2}$ "D" units, $RSiO_{3/2}$ "T" units and SiO_2 "Q" units, to satisfy the relationship $R_nSiO_{(4-n)/2}$ where n is from about 1.0 to about 1.50 and R is a methyl group. See e.g. claim 3; instant claim 5. The organosiloxane resin also comprises $R_3SiO_{1/2}$ "M" units and SiO_2 "Q" units, wherein the ratio of $R_3SiO_{1/2}$ to SiO_2 is about 0.7. See e.g. claim 7; instant claim 6. The use of the term "about" in the instant invention broadens the range of the ratio and is anticipated by the about 0.6 of the prior art. The diorganopolysiloxane polymer is polydimethyl siloxane. See e.g. claim 8; instant claims 1 and 8-11. The modified silicone has a viscosity of from about 100 cSt to about 2,000,000 cSt at 25 degrees C. See e.g. claim 11 line 4; instant claims 12 and 13. The volatile carrier is selected from the group consisting of hydrocarbon oils, silicone oils and mixtures thereof. See e.g. claim 17; instant claim 14. The volatile carrier is specifically isododecane. See e.g. claim 18; instant claim 15. A topcoat is added over the composition. See e.g. col 10 lines 48-65; instant claim 1.

Claim 16 recites the composition of claim 1 as having a viscosity from about 500 cP to about 15,000 cP. While this is not specifically stated in the prior art the properties of the composition recited by Applicants are reasonably deemed to be present in the composition suggested by the prior art, because the components are the same. It is noted that *In re Best* (195 USPQ 430) and *In re Fitzgerald* (205 USPQ 594) discuss the support of rejections wherein the prior art discloses subject matter in which there is reason to believe inherently includes functions that are newly cited or are identical to a product instantly claimed. In such a situation the burden is shifted to the applicants to

"prove that subject matter shown to be in the prior art does not possess characteristic relied on" (205 USPQ 594, second column, first full paragraph).

DRECHSLER does not explicitly teach the use of a kit nor does it teach that the topcoat composition is selected from aminosilicones, carboxy modified silicones, epoxy modified silicones and mixtures thereof.

NICHOLS teaches the use of a kit and composition to enhance the appearance of the lips. See e.g. col 1 lines 13-19; instant claims 1 and 22-24.

Claim 1 recites a topcoat composition, however this is a recitation of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

The components are known in DRECHSLER in view of NICHOLS, although not specifically as a topcoat. "It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). In this case, a person having ordinary skill in the art would have known to use aminosilicones, for example, as a topcoat because its properties and purpose for inclusion in a lip composition would be the same.

It would have been obvious to one of ordinary skill in the art at the time of the invention to practice a cosmetic composition containing modified silicones, diorganopolysiloxane polymer, organosiloxane resin, a volatile carrier, and a topcoat composition because DRECHSLER teaches it is within the skill of the art to use modified silicones to improve the luster or smear resistance of lip compositions and because NICHOLS teaches it is within the skill of the art to have a cosmetic composition with a topcoat composition. One would have been motivated to do so in order to receive the expected benefit, as suggested by DRECHSLER and actually exemplified by NICHOLS. Absent any evidence to the contrary, and based upon the teachings of the prior art, there would have been a reasonable expectation of success in practicing the instantly claimed invention.

Furthermore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to make a composition and kit for packaging said composition. Depending on the intended use, one of ordinary skill in the art would have been motivated to package a composition, such as a topcoat composition, in a kit. Kits provide a convenient mechanism to disperse products to consumers. By combining the teachings of DRECHSLER with those of NICHOLS and producing a kit comprising a topcoat composition, there is a reasonable expectation that said kit would provide a convenient mechanism to disperse a topcoat product to consumers.

Response to Arguments

Applicant's arguments filed on 3/27/2008 have been fully considered but they are not persuasive. In response to the 12/27/2007 Non-Final Office Action, Applicant has asserted the following:

(A) With respect to the 35 U.S.C. § 102(b) rejection over DRECHSLER, Applicant amended claim 1 to incorporate claim 7 and claim 17 and asserts that DRECHSLER does not teach or suggest a combination of diorganopolysiloxane polymer and aminosilicones in an anhydrous mixture.

(B) With respect to the 35 U.S.C. § 103(a) rejection over DRECHSLER in view of NICHOLS, Applicant asserts there is no motivation to combine DRECHSLER and NICHOLS.

(C) With respect to the 35 U.S.C. § 103(a) rejection over DRECHSLER in view of NICHOLS, Applicant asserts the "subject matter as a whole" is not rendered obvious because the combination does not teach or suggest all of the claim limitations. Specifically, the references are both basecoat compositions and the instant application is a topcoat composition. Additionally, NICHOLS only teaches a kit comprising a cosmetic and a cosmetic remover, thus the combination of the references do not suggest or teach a lip cosmetic kit comprising a topcoat composition.

With regard to argument (A), the Examiner asserts that this argument is rendered moot in light of the withdrawal of the 102(b) rejection and the new 103 rejection.

With regard to argument (B), the Examiner asserts that there is motivation to combine DRECHSLER and NICHOLS to practice a cosmetic composition containing modified silicones, diorganopolysiloxane polymer, organosiloxane resin, a volatile carrier, and a topcoat composition because DRECHSLER teaches it is within the skill of the art to use modified silicones to improve the luster or smear resistance of lip compositions and because NICHOLS teaches it is within the skill of the art to have a cosmetic composition with a topcoat composition. Together the improved cosmetic lip product of the instant invention is obviated.

With regard to argument (C), the Examiner asserts that the "subject matter as a whole" is rendered obvious because the recitation in claim 1 of a topcoat is merely intended use. As previously stated, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case there is no structural difference between a topcoat and a basecoat, only a difference in the use of the same composition, thus the prior art reads on the claim. Additionally, the insertion of "kit" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand

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alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the instant case, the specification does not provide any definition for "kit", nor does the specification or claim clarify any structural limitation or depend on the preamble for completeness, thus the kit is viewed as obvious because one of ordinary skill in the art would have been motivated to package a composition, such as a topcoat composition, in a kit. Kits provide a convenient mechanism to disperse products to consumers as taught in NICHOLS.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TRISTAN J. MAHYERA whose telephone number is

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571-270-1562. The examiner can normally be reached on Monday through Friday 9am-7pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL P. WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tristan J Mahyera/
Examiner, Art Unit 1615

/MP WOODWARD/
Supervisory Patent Examiner, Art Unit 1615